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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/461,436	12/14/1999	SHUJI HINUMA	45753-DIV2	3810

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EXAMINER

PAK, MICHAEL D

ART UNIT	PAPER NUMBER
1646	13

DATE MAILED: 03/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. <b>09/461,436</b>	Applicant(s) <b>Hinuma et al.</b>
Examiner <b>Michael Pak</b>	Art Unit <b>1646</b>



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Oct 29, 2001

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 19-26 is/are pending in the application.

4a) Of the above, claim(s) 20-26 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 19 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

15)  Notice of References Cited (PTO-892)

18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

19)  Notice of Informal Patent Application (PTO-152)

17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20)  Other: \_\_\_\_\_

**DETAILED ACTION**

1. The preliminary amendment filed 14 December 1999 (Paper No. 7) has been entered.

***Election/Restriction***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I, claim(s) 19, drawn to a protein, classified in class 530 subclass 350.

Group II, claim(s) 20-24, drawn to a DNA, vector, method of producing protein, and transformant, classified in class 435 subclass 69.1.

Group III, claim(s) 25, drawn to method for determining a ligand to the protein for stimulation, classified in class 435 subclass 375.

Group IV, claim(s) 26, drawn to a screening method for a novel compound for inhibiting, classified in class 435 subclass 7.8.

The inventions are distinct, each from the other because of the following reasons:

The products of inventions I and II, are distinct each from the other, because they are drawn to products having materially different structures and functions.

The methods of inventions III-IV are distinct, each from the other, because they are drawn to processes having materially different process steps, which are practiced for materially different purposes.

The product of inventions I is not used in or produced by the process of inventions III-IV, and is distinct from each other.

Inventions of product of Group II, and any one of inventions of the processes of Groups III and IV are related as products and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MEP. § 806.05(h)). In the instant case the products can be used in the alternative process of group III or IV.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their different classifications and the search required for any one of inventions I-IV is not required for any other invention I-IV, thus, restriction for examination purposes as indicated is proper.

During a telephone conversation with David Conlin on 8 March 2002 and a provisional election was made with traverse to

prosecute the invention of I, claim 19. Affirmation of this election must be made by applicant in responding to this Office action. Claims 20-26 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

#### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 19 is rejected under 35 U.S.C. 101, because the claimed invention is directed to non-statutory subject matter. The claims encompass a naturally occurring DNA coding a G-protein

coupled receptor and a G-protein coupled receptor protein and thus does not involve the hand of man to isolate or purify the receptor.

4. No claim is allowed. SEQ ID NO:54 is free of the art.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak, whose telephone number is (703) 305-7038. The examiner can normally be reached on Monday through Friday from 8:30 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*Michael D. Pak*

Michael Pak  
Primary Patent Examiner  
Art Unit 1646  
16 March 2002